

1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

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10 Ex parte STEPHEN W. COMISKY
11 And BARRETT O. COMISKEY

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14 Appeal 2007-1182
15 Application 10/020,136
16 Technology Center 1700

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19 Oral Hearing Held: May 8, 2007
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23 Before EDWARD C. KIMLIN, CHUNG K. PAK, and PETER F. KRATZ,
24 Administrative Patent Judges

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28 ON BEHALF OF THE APPELLANT:
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MAY 25 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

1 The above-entitled matter came on for hearing on Tuesday,
2 May 8, 2007, commencing at 2:15 p.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Paula
4 Lowery, Notary Public.

5 THE CLERK: Calendar Number 4, Appeal Number 20071182,
6 Mr. Scott.

7 JUDGE KIMLIN: Good afternoon, Mr. Scott.

8 MR. SCOTT: Good afternoon.

9 JUDGE KIMLIN: We have a court reporter today, if you're not
10 aware of it. I'm not sure you are.

11 MR. SCOTT: Is it the practice of the Board now to --

12 JUDGE KIMLIN: It's a relatively new practice, yes. We're
13 making the transcript part of the file record.

14 MR. SCOTT: So the transcript will be made a part of the
15 record?

16 JUDGE KIMLIN: Exactly.

17 MR. SCOTT: All right, excellent.

18 JUDGE KIMLIN: You can begin.

19 MR. SCOTT: Thank you.

20 May it please the Board, I think one of the fundamental
21 elements about this invention is its fundamental simplicity. It is a novel,
22 creative and -- I don't know if the members of the Board are aware of this --
23 but is now used ubiquitously and frequently. You've probably seen it at
24 sporting events.

25 It is a novel and creative idea, and I think the problem we've
26 had is its fundamental simplicity, but the important point is, it uses the fact
27 that many athletes and many people who attend sporting events or otherwise

1 -- any outdoor activity -- want to have something to prevent the glare of the
2 sun into their eyes.

3 Also, particularly when sporting events are televised or
4 otherwise, you can take a photo of the person's face, and you can cut off the
5 logo that's on the hat or shoulder pads, but you will see the eyes and things
6 underneath it.

7 Accordingly, the invention provides a method by which you
8 can identify with a particular school, a sports team, a manufacturer or logo,
9 and therefore -- just as an example, if Tiger Woods is at the U.S. Open and
10 he has these anti-glare patches, he can identify with some product, such as
11 Nike, that he wishes to identify himself with.

12 Similarly, members of a football team can identify themselves
13 with their own team and otherwise.

14 This fundamental aspect, and fundamental simplicity of it, is
15 the reason that the examiner's rejection is, in fact, fundamentally an example
16 of a hindsight reconstruction of this invention.

17 Now, with respect to the independent findings -- and I want to
18 say that -- I will address during my presentation the fact of the Supreme
19 Court's decision in KSR, and I don't believe that that in any way impacts the
20 outcome of this appeal because with all of the statements therein, the
21 important point is that this invention is, in fact, patentable and is nonobvious
22 for the very reasons that were brought forth by the Supreme Court in the
23 KSR case.

24 First, looking at the independent claim 21, which requires a
25 patch that's safe to be applied under the eye, and then positioned within that
26 patch a symbol or any shape that's going to provide communication, such as
27

1 a sports team or manufacturer or apparel manufacturer, and it's going to be
2 removable.

3 JUDGE KIMLIN: Let me ask you, Mr. Scott, just in terms of
4 the breadth of this independent claim 1, would this encompass a situation
5 where you would take the patch of the primary reference to Micchia and
6 perhaps take a colored pen and write a message on his black patch that says,
7 Hi, Mom, or something to that effect?

8 MR. SCOTT: Okay. In other words, with some sort of
9 indelible -- for example a white marker?

10 JUDGE KIMLIN: Right. If you just modified the patch of the
11 primary reference and wrote a message on it.

12 MR. SCOTT: Well, yes, it would -- as long as it provided
13 communication.

14 JUDGE KIMLIN: That would be covered by your claim.

15 MR. SCOTT: That would be covered by the claim.

16 JUDGE KIMLIN: And why wouldn't that be obvious?

17 MR. SCOTT: Well, because the fact is that none of the
18 references that are cited in any way render or provide any kind of functional
19 suggestion or any kind of teaching that you would place a communication
20 underneath the eye.

21 Again, that's --

22 JUDGE KIMLIN: What about KSR's indication that common
23 sense is available?

24 MR. SCOTT: It does say that. Common sense is clearly
25 available, as long as common sense is evidenced from the evidence of record
26 in an application or a case.

27

1 You can't, as the judges fully understand -- common sense is
2 very, very easy to state and very, very glibly presented when it's viewed on
3 this side of the invention.

4 That's why when you were talking about common sense, which
5 -- there's no question that KSR says that common sense absolutely should be
6 consulted to understand what the level of ordinary skill in the art is, and I
7 wouldn't dispute that. But that level of ordinary skill and common sense has
8 got to be drawn from some sort of evidentiary basis.

9 JUDGE KIMLIN: Well, isn't it well within the purview of not
10 just a skilled artisan but, say, the ordinary common man on the street that
11 you can write a message on a black background? That's pretty well known,
12 isn't it?

13 MR. SCOTT: Again, when you have an instrument which
14 permits that, like a blackboard. What I would suggest to you is that it is not
15 the case in the situation of a piece of athletic equipment of this type, which
16 is intended to prevent the reflective light going into the eye, to write a
17 message on that kind of device.

18 Now, it is apparent to write on some sort of sports apparel
19 indications of teams, but I know of no evidence which would suggest it to be
20 within the skill of the artisan to put a message on a patch of the type of
21 Micchia.

22 Remember, the idea of having any glare in sporting events is
23 recognized to be -- I mean, Micchia is a patch. It's a fairly recent
24 development because of using a patch that's replaceable and removable, but
25 the use of grease paint or other kinds of ways to place anti-glare material
26 under the eye is well known.

27

1 In that entire period of time up until the applicant's invention
2 here in 1994, there was never any kind of evidence that it was within the
3 skill of the art to add communication to that type of under-eye device.

4 JUDGE KIMLIN: Well, isn't the primary purpose of Micchia's
5 patch to reduce glare in the eyes?

6 MR. SCOTT: Yes, no question about that.

7 JUDGE KIMLIN: And I would assume that's also at least one
8 of two primary purposes of your patch as well, right?

9 MR. SCOTT: Oh, yes, no question about that.

10 JUDGE KIMLIN: In addition to communicating.

11 MR. SCOTT: In addition to communicating, preventing
12 reflected light into the eyes.

13 JUDGE KIMLIN: Isn't it also true that if you change the color
14 from black to some other color that provides communication, you're going to
15 be compromising the reduction of glare? As a matter of fact, maybe even
16 creating glare in the eye from the message?

17 MR. SCOTT: If it's not configured to be nonreflective in the
18 sense of keeping the amount of the area of the symbol, just as a functional
19 thing, not in terms of the claim -- just functionally, the way this operates is
20 that you would have, like, an outline -- and this is in claim 31, the interior
21 and exterior boundaries -- with a small amount of white or contrasting color.

22 Or alternatively -- and this is used sometimes -- you would have
23 a name or some other very small symbol that can still be seen. That way
24 you, obviously, to some degree minimally compromise the non-reflective
25 nature of it, but experience has shown that it's insufficient to depart from the
26 primary purpose of the invention.

27

1 That is a functional element that the applicant here considered,
2 and in developing this particular figure 7 embodiment of the invention, it's
3 specifically claimed in these claims he took into account that he would make
4 the symbol of such a size that that compromise would be minimized.

5 JUDGE PAK: Counsel, your symbol is simply descriptive
6 material, not necessarily performs any particular utility?

7 MR. SCOTT: It provides the utility of identifying and
8 communicating a particular affiliation. It communicates, and that
9 communication is functional.

10 In the case of the particular embodiment, a panther, which
11 could be a team logo, or any other kind of recognizable logo --

12 JUDGE PAK: So Counsel, are you saying that the Cowboy
13 helmet with the star on it, that's not a descriptive matter, it's a functional
14 matter because it symbolizes somehow -- performs a utilitarian function of
15 associating that helmet with a particular team?

16 MR. SCOTT: Yes. It's like any uniform or symbol. It
17 identifies who that player is.

18 JUDGE PAK: Let's go a step further, Counsel. For a song, the
19 title of the song, the music that you want to hear. Is it also utilitarian -- not a
20 descriptive matter -- simply because it's associated with the song?

21 MR. SCOTT: Well, it is utilitarian when you use the title of the
22 song to identify it and select it. Here the utilitarian nature of what's being
23 done is to identify the player with his team, much the same way the Cowboy
24 helmet or star, or whatever the symbol is, identifies the player with his or her
25 team in the same way that the color of the jersey does.

26 So it has a functional utility, and that functional utility is
27 communicating that item of identification with which the person is wearing

1 the patch associates him or herself.

2 JUDGE PAK: So from your perspective, logos or trademarks
3 are all patentable items as they serve in functions because they are
4 associated with their products, right? They communicate to the people that
5 the baggage belongs to Louis Vuitton the same way you are associating that
6 mark with a certain team, right?

7 MR. SCOTT: Well --

8 JUDGE KIMLIN: He wouldn't want to go that far.

9 MR. SCOTT: No, I wouldn't go that far. I mean, as with any
10 argument that's reductio ad absurdum, obviously, that's not correct. In other
11 words, the trademark identifies the item.

12 What's happened here is -- and the reason it's functional is
13 because in this case the symbol associated with the team member is being
14 conveyed as a part of the eye black functionality and helps identify in a
15 visual way, particularly in television and the very visual media that we have
16 now, identifies that person with that team when the picture is just of the face
17 and close-up.

18 There's no question that these symbols are important because --
19 as it's recognized in the art -- you know, repeating the association of a
20 member with his team and identifying that particular association is important
21 just for all kind of branding. So it does have a functional purpose.

22 Again, a trademark -- I mean, I would say that just as a matter
23 of argument that there could be circumstances when placing a trademark in a
24 patentable invention, that limitation combined with other patentable
25 elements, it could be a limitation in a claim. It's not independent.

1 JUDGE PAK: So from your perspective, a Dallas Cowboy
2 helmet isn't patentable over a Redskin helmet because they both perform
3 different functions identifying different teams?

4 MR. SCOTT: No.

5 JUDGE PAK: I'm just trying to interpret your argument.

6 MR. SCOTT: No, I understand your point. The point here is,
7 if, in fact, as a part of an otherwise patentable invention, the distinction of
8 communicating and identifying the source of goods was a part -- or the
9 source of the team was a part of that patentable invention -- just because that
10 limitation of communication was a trademark would not otherwise render
11 the subject matter unpatentable.

12 JUDGE KRATZ: Would this read on someone who has a patch
13 under the eye -- for example, a bandage or a stitch because they had an
14 injury -- and then they take the prior art and put it on there, and now you're
15 going to have a shape underneath the surface that's visible and
16 communicates the injury, you've had it treated? Do you have a read on that?

17 MR. SCOTT: No, because in that case the thing that's doing
18 the communication is not a part of the patch, it's underneath it. If I
19 understand your question correctly.

20 JUDGE KRATZ: Right.

21 MR. SCOTT: In other words, the symbol has to be within the
22 interior surface of the patch and a color contrasting it in one embodiment, or
23 in the other claim it has to be a boundary of interior/exterior definition that
24 shows the symbol.

25 I think one of the things -- again, addressing the KSR case, as
26 this allocation was considered prior to that -- the important point is whether
27

1 or not in combining the various references, they're operating functionally the
2 same.

3 In other words, there's no question about Micchia is an anti-
4 glare patch. That functions as an anti-glare patch, and that's what it does.
5 I'm not going to dispute that.

6 The point is to find something that would show a symbol and
7 that would allegedly be combinable with Micchia. The examiner has gone
8 to the decorative arts to what's intentionally a beauty mark.

9 This, interestingly enough -- and I think it shows why this
10 combination is not correct -- the beauty mark is an outline -- well, it's a silk
11 patch with some contrasting hues. It's not really in the patch.

12 It's not really explained whether those are color differences or
13 not, because the whole point of it is to have the appearance of a beauty mark
14 or birth mark, which is a hue that is kind of compatible with rather than
15 contrasting with the skin.

16 Then as a part of this beauty mark, you're going to have
17 portions of the ink that contain perfume so that as the wearer has -- you
18 know, wears the butterfly, he or she -- she in this case as shown in the patent
19 -- the perfume will be emitted because of the heat of the body.

20 I suggest to you that it would be improper to place an item that's
21 going to emit perfume near the eye. That's just not logical because of the
22 fact that perfume by its nature would irritate the eye.

23 In fact, one of the things about Micchia points out that you want
24 to have something that's sufficiently hypo-allergenic so that it won't interfere
25 with the eye. It says, Use something that's known to be clean and safe
26 because it's going to be near the eye, and we don't want to irritate it.

27

1 JUDGE KIMLIN: Isn't it fundamental, Counsel, that it's not
2 necessary for a finding of obviousness that the features of the secondary
3 reference be incorporated fully into the primary reference? The secondary
4 reference can be relied upon just for a suggestion of a particular feature?

5 MR. SCOTT: That's true, but in understanding what it teaches
6 and suggests, you have to look at the reference as a whole.

7 JUDGE KIMLIN: Well, the examiner is not suggesting that the
8 tattoos of the secondary reference be placed under the eye. He's simply
9 using that as evidence that it was known in the art to use decals that stick to
10 the body to communicate a message.

11 MR. SCOTT: Again, I think -- yes, that is what she said, but
12 the important point here -- there are two points that need to be made in
13 response to your inquiry.

14 One, that secondary reference has to be viewed in terms of what
15 it suggests to the skilled artisan as a whole. You can't just pick and choose
16 and use hindsight. You have to say, Okay, what does this reference, in
17 common sense and logic and to the skilled artisan, suggest about what's
18 obvious based on the primary reference?

19 JUDGE KIMLIN: Wouldn't it suggest to you that you can use
20 an adhesive decal to place on your body to communicate a message?

21 MR. SCOTT: No, that's the second point I would make. I
22 wouldn't.

23 JUDGE KIMLIN: Why not?

24 MR. SCOTT: Because it doesn't communicate a message.

25 JUDGE KIMLIN: What part of a butterfly is not a
26 communication?
27

1 MR. SCOTT: It isn't intended to identify or communicate. It's
2 intended to be decorative. I think that's an important point.

3 JUDGE KIMLIN: Why doesn't it communicate the image of a
4 butterfly?

5 MR. SCOTT: Because it does not -- it does not suggest or in
6 any way teach that the decorative element -- which is a beauty mark,
7 remember -- in other words, which could be in any shape.

8 And it's just different hues of the skin are to be identified with
9 any particular form of communication or symbol as the word
10 communication is normally used to convey -- it's in the brief, the typical
11 definition of communication.

12 It's something that conveys through symbols or otherwise a
13 particular meaning or understanding which the person looking at it can
14 identify or associate.

15 The butterfly is purely decorative. It doesn't, as the other
16 member said, it doesn't provide any kind of functional communication in
17 terms of identifying with a particular team or other cognizable entity.

18 JUDGE KIMLIN: We don't have a recitation here of any
19 functional communication. We simply have to provide communication as
20 broadly as that term can be defined.

21 MR. SCOTT: That is correct, there's no question about that,
22 but communication in and of itself means just that. It means that it conveys
23 something under which the person who's receiving the communication can
24 understand and identify.

25 I suggest to you that looking at the butterfly doesn't tell you
26 anything other than it's a beauty mark. It doesn't communicate anything to
27 you.

1 JUDGE KIMLIN: It seems to communicate a beauty mark.

2 MR. SCOTT: Well, ornament -- again, referring to what the
3 other member had suggested -- an ornament does not provide
4 communication. That is a distinct difference in this invention.

5 MR. KIMLIN: I think we're getting near the end here, if you
6 can wrap it up.

7 MR. SCOTT: All right. I just want in closing to say that the
8 other examples of possible communications, such as the heart and the
9 Google search of butterfly, I don't think that can be evidence on which the
10 examiner can rely because there's no identification that those kinds of
11 symbols existed in the art prior to applicant's invention.

12 I don't think they can provide the kind of common sense
13 evidence that KSR requires.

14 JUDGE KIMLIN: Any further questions?

15 JUDGE KRATZ: No questions.

16 JUDGE PAK: No.

17 MR. SCOTT: Thank you very much.

18 JUDGE KIMLIN: Mr. Scott, thank you for coming.

19 (Whereupon, the proceedings at 2:40 p.m. were concluded.)